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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,126	01/02/2002	Vikrant Sharma	3790-012018	7425
28289	7590	08/10/2005	EXAMINER	
THE WEBB LAW FIRM, P.C. 700 KOPPERS BUILDING 436 SEVENTH AVENUE PITTSBURGH, PA 15219			NGUYEN, THANH T	
		ART UNIT		PAPER NUMBER
		2144		

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/038,126	SHARMA, VIKRANT
	Examiner Tammy T. Nguyen	Art Unit 2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 May 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-7,9-13 and 16-25 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-7,9-13 and 16-25 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 02 January 2002 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |



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*Detailed Office Action*

1. This action is in response to the amendment filed on May 9, 2005.
2. Claims 8, 14, and 15 are cancelled.
3. Claims **1-7, 9-13, 16-25** are pending.

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 25 is rejected under 35 U.S.C. 102(e) as being anticipated by Shaw et al. (USPN 6,199,106)– Date of Patent: March 6, 2001, herein referred to as “Shaw”).

6. As to claim 25, Shaw teaches the invention as claimed, including an email message interface comprised of a “from” field (from 815 of fig.8) a “To” field (to 1202 of fig.12), a “Subject” field (subject 1204 of fig.12), and an email message text window (message text window 1205 of fig.12), wherein a Person-to-Person message and an advertising banner are displayed within the email message text window (banner 800 of fig.12), further wherein the advertising banner has an active link associated therewith (link 800 of fig.12).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 9-13, 16-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw et al., (hereinafter Shaw) U.S. Patent No. 6,199,106 in view of Gardenswartz et al., (hereinafter Gardenswartz) U.S. Patent No. 6,055,573.

9. As to claim 1, Shaw teaches the invention as claimed, including a system for delivering email-based advertising to discrete users, comprising: (a) a first computer connected to a computer network, the first computer configured to transmit an email message (computer

101 of fig.1) including identification data and one or more email client objects (see fig.8); (b) the first computer connected to the computer network, the second computer configured to receive the email message from the first computer, \_configured such that in response to displaying the email message the second computer transmits the identification data and the one or more email client objects (external parties, col.9, lines 35-51); and (c) at least one server remote from the first and connected to the computer network, the server configured to receive the identification data and the one or more email client objects (Fig.8), wherein the server in response to receiving the identification data and the one or more email client objects is configured to select an advertisement (see col.6, lines 60-65), the server configured to transmit the advertisement to the second computer, so that the second computer displays the advertisement in a message field of the email message (see col.12, lines 43-60, col.13, lines 11-28). But Shaw does not explicitly teach a second computer remotely. However, Gardenswartz teaches a second computer (see fig.1). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Gardenswartz into the computer system of Shaw to a second computer because it would have an efficient system that can provide communicating a computer associated with others by delivery information from/to each other.

10. As to claim 9, Shaw teaches the invention as claimed, wherein the server is a banner server, the banner server is programmed to select an appropriate advertisement as a function of the identification data and the one or more of the email client objects (fig.8).

11. As to claim 10, Shaw teaches the invention as claimed, wherein the banner server is comprised of at least the following: (a) a web server; (b) an application server; and (c) a database backend (application server 104 of fig.1)
12. As to claim 11, Shaw teaches the invention as claimed, wherein the server is configured to provide an advertisement and optionally an active link associated with the advertisement, to be transmitted to the second computer (see col.19, lines 9-39).
13. As to claim 12, Shaw teaches the invention as claimed, wherein the first computer and the second computer is configured to utilize instant messaging software or wireless communication software to communicate email messages to and from each other (see col.6, lines 15-40).
14. As to claim 13, Shaw teaches the invention as claimed, including a method of delivering email-based advertising between a first computer and a second computer on a network, the method comprising the steps of: (a) transmitting to a server on the network identification data and one or more email client objects received in an email from the first computer (Fig.4 communication connect between client and server, fig.8) (see col.4, lines 40-52, and col.9, lines 35-51); (b) receiving, the identification data and optionally one or more of the email client objects at the server, and in response thereto selecting an advertisement (Fig.12) (see col.6, lines 60-67); (c) transmitting the advertisement (recipient email with ads of fig.12); and (d) embedding the advertisement in a message field of the email message, such that the advertisement is displayed on a screen (message sent with ads of fig.12). But Shaw does not explicitly teach a second computer remotely. However, Gardenswartz teaches a second computer (see fig.1). It would have been

obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Gardenswartz into the computer system of Shaw to a second computer because it would have an efficient system that can provide communicating a computer associated with others by delivery information from/to each other.

15. As to claim 16, Shaw teaches the invention as claimed, wherein the identification data is an affiliate I.D. number and the email client objects include at least a subject line (Subject 1204 of fig.1204).
16. As to claim 17, Shaw teaches the invention as claimed, wherein the server counts the number of times a particular ad is pulled and sent for attachment to an email message (time of fig. 10).
17. As to claim 18, Shaw teaches the invention as claimed, wherein the server utilizes counting software to limit the number of times a particular recipient of an email message sees the same ad (status 1002 of fig.10).
18. As to claim 19, Shaw teaches the invention as claimed, wherein the server credits a partner, with reference to the identification data, for each time an advertisement is viewed by a unique recipient wherein the partner is a user of the first computer system (recipient 1202 of fig.12).
19. As to claim 20, Shaw teaches the invention as claimed, wherein the server instructs billing software to generate a payment, either in the form of electronic payment or printed check, to the partner based on the number of advertisements placed by the server in connection with that partner's identification data (see fig.12).

20. As to claim 21, Shaw teaches the invention as claimed, wherein the server works in conjunction with billing software to generate bills for advertisers whose advertisements are placed by the server, based on the number of times the advertisements are sent from the server for attachment to an email message (text message with ads shown in fig.12).
21. As to claim 22, Shaw teaches the invention as claimed, wherein, in addition to the advertisement, the server sends an active link (URL) to enable a recipient to click on the advertisement and access the advertiser's website (URL 800 of fig.12).
22. As to claim 23, Shaw teaches the invention as claimed, wherein the advertisement is one of text and graphics (text 1205, graphic 801 of fig.12).
23. As to claim 24, Shaw teaches the invention as claimed, wherein the advertisement includes an active link associated therewith (link 800 of fig.12).
24. Claims 2-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw et al., (hereinafter Shaw) U.S. Patent No. 6,199,106, and Gardenswartz et al., (hereinafter Gardenswartz) U.S. Patent No. 6,055,573 in view of Franco et al., (hereinafter France) U.S. Patent No. 6,687,746.
25. As to claim 2, Shaw does not explicitly teach a mail client configured to embed HTML code into the email message. However, Franco discloses a mail client configured to embed HTML code into the email message (see col.10, lines 17-40). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Franco into the computer system of Shaw to have a mail

client configured to embed HTML code into the email message because it would have an efficient system that can provide specific functions to format and layout the information in a Web page.

26. As to claim 3, Shaw teaches the invention as claimed, wherein the email message is comprised of the HTML code, the HTML code comprised of the identification data and the one or more of the email client objects (fig. 1).
27. As to claim 4, Shaw teaches the invention as claimed, wherein the identification number identifies a partner, the partner being a user of the first computer system (member profile of fig. 7).
28. As to claim 5, Shaw teaches the invention as claimed, wherein the email client objects comprise at least one of the following: (a) a recipient's email address; (b) a subject line; (c) a time of the day; (d) an IP address; and (e) a profile of the partner (a recipient's email address of fig. 12).
29. As to claim 6, Shaw does not explicitly teach a second email client comprised of an HTML interpreter, the HTML interpreter configured to interpret the HTML code. However, Franco discloses a mail client configured to embed HTML code into the email message (see col. 10, lines 17-40). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Franco into the computer system of Shaw to have a mail client configured to embed HTML code into the email message because it would have an efficient system that can provide specific functions to format and layout the information in a Web page.

30. As to claim 7, Shaw does not explicitly teach an identification data and the one or more email client objects are read from the HTML code. However Franco disclose HTML code (see col.10, lines 17-40). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Franco into the computer system of Shaw to have a mail client configured to embed HTML code into the email message because it would have an efficient system that can provide specific functions to format and layout the information in a Web page.

***Conclusion***

31. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

32. Any inquiries concerning this communication or earlier communications from

the examiner should be directed to **Tammy T. Nguyen** who may be reached via telephone at **(571) 272-3929**. The examiner can normally be reached Monday through Friday between 8:00 a.m. and 5:00 p.m. eastern standard time.

If you need to send the Examiner, a facsimile transmission regarding this instant application, please send it to **(703) 872-9306**. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, David Wiley, may be reached at **(571) 272-3923**.

*TTN*  
July 28, 2005



DAVID WILEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100